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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,958	12/14/2001	Jari Vallstrom	413-010736-US(PAR)	1837
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PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			POWERS, WILLIAM S	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,958

Applicant(s)

VALLSTROM, JARI

Examiner

William S. Powers

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2 and 4-17 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

As to claims 1, 11 and 14, utilizing a mobile subscriber identification number of a SIM card to connect to a cellular network is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). There is no reference to the mobile subscriber identification number of a SIM card in the specification, original claims or drawings being used to connect the mobile terminal to the cellular network. The mobile terminal of the claimed invention would not be able to connect to the cellular network without this data.

As to claims 2, 4-10, 12, 13 and 15-17, they are rejected based on their dependency to rejected base claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 4, 5 and 6, the claims, as written, depend from a cancelled base claim and are, therefore, indefinite. For purposes of examination, Examiner assumes that claims 4, 5 and 6 each depend from claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 5, 7-9, 11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,933,785 to Tayloe.

As to claim 1, Tayloe teaches:

- a. Means for storing a different personal identification code for each user of the terminal (data is stored in a SIM of a mobile terminal (column 3, lines 39-45) that includes PINs for each universal number (column 5, lines 55-59)).
- b. Means for carrying out user identification during login by means of a user input before permitting use of the terminal, said user input comprising the personal identification code of a respective one of the users (user must enter the correct PIN code for user's account with the keypad of a mobile terminal to activate said mobile terminal) (column 2, line 59-column 3, line 7).
- c. Means for connecting the terminal to the cellular network after successful user identification by utilizing a mobile subscriber identification number of the SIM card (column 1, lines 14-27).

As to claim 2, Tayloe teaches the SIM card further comprises means for storing data used in a shared manner by all users of said terminal (data on available networks) (column 4, lines 45-50).

As to claim 4, Tayloe teaches said personal identification code required in the identification of a user comprises at least one of the following codes: user-specific PIN code, user-specific PUK code (PIN code is entered to unlock SIM card) (column 2, lines 61-65).

As to claim 5, Tayloe teaches said personal identification code required in the identification of a user further comprises at least one user-specific password (PIN code is entered to unlock SIM card) (column 2, lines 61-65).

As to claim 7, Tayloe teaches the SIM card further comprises at least one encryption key used in user-specific authentication (column 3, 39-49).

As to claim 8, Tayloe teaches the SIM card further comprises user-specific encryption keys used to encrypt a connection (column 3, lines 62-65).

As to claim 9, Tayloe teaches the SIM card further comprises other user-specific data needed in the operation of the terminal (column 4, lines 50-55).

As to claim 11, Tayloe teaches:

- a. A terminal is shared between different users having different personal identification codes (data is stored in a SIM of a mobile terminal (column 3, lines 39-45) that includes PINs for each universal number (column 5, lines 55-59)).
- b. Said terminal is arranged so as to perform user identification during login (user must enter correct PIN code for user's account with the keypad of a mobile terminal to activate said mobile terminal) (column 2, line 59-column 3, line 7) before allowing a connection of the terminal to the cellular network by a mobile subscriber identification number of the SIM card (column 1, lines 14-27).

- c. The means for identifying the user comprises in the SIM card a means for identifying one user from at least two users entitled to use the terminal on the basis of at least one user-specific identification code which the user inputs during login (column 3, lines 55-65).
- d. Said user-specific identification code is the personal identification code of the user (PIN code is entered to unlock SIM card) (column 2, lines 61-65).

As to claim 14, Tayloe teaches:

- a. The user of the terminal is identified during login on the basis of a personal identification code which the user inputs (user must enter the correct PIN code for user's account with the keypad of a mobile terminal to activate said mobile terminal) (column 2, line 59-column 3, line 7).
- b. The user identification is carried out by matching the personal identification code given by the user against identification codes of different users stored on a SIM card of the terminal (user must enter the correct PIN code for user's account with the keypad of a mobile terminal to activate said mobile terminal (column 2, line 59-column 3, line 7) each user has a PIN code for his/her account on the SIM card (column 5, lines 55-64)).
- c. The personal identification code given by the user of the terminal is among the said identification codes stored in the SIM card (user must enter correct PIN code for user's account with the keypad of a mobile terminal to activate said mobile terminal) (column 2, line 59-column 3, line 7), to allow connection of the terminal to

the cellular network by utilizing a mobile subscriber identification number of the SIM card (column 1, lines 14-27).

As to claim 15, Tayloe teaches said personal identification code which entitles the user to use the terminal, is a PIN code (PIN code is entered to unlock SIM card) (column 2, lines 61-65).

As to claim 16, Tayloe teaches a step in which the user of the terminal is requested for a second additional identifier/password for activating the terminal (column 5, lines 57-59).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 6 and 10 and claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,933,785 to Tayloe, as applied to claim 1 and claim 11 respectively above, in view of "Realization of a Mobile Data Application in TETRA" by Lammerts et al. (hereto referred to as Lammerts).

As to claim 6, Tayloe teaches user specific identification (column 3, lines 45-49), but does not specifically teach the use of a user specific ITSI code. However, in an analogous art, Lammerts teaches the use of user-specific ITSI code in a TETRA network (page 248, paragraph 2).

Therefore, it would be obvious to one with ordinary skill in the art at the time the invention was made to use the generic PIN codes of Tayloe with the specific ITSI code of Lammerts in order to identify each entity in a TETRA network as suggested by Lammerts (page 248, paragraph 2).

As to claims 10, 12 and 13, Tayloe as modified teaches subscribers to a communication device that has access to all cellular systems in a secure manner (column 1, lines 29-35), but does not specifically mention authorities as subscribers. However, in an analogous art, Lammerts teaches that "Public Safety organizations" use TETRA networks to ensure high capacity and secure transmissions (page 247, paragraph 3).

10. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,933,785 to Tayloe as applied to claim 14 above, and further in view of US Patent No. 6,513,719 to Imura.

As to claim 17, Tayloe teaches the use of a PIN code to access the network (Tayloe, column 2, lines 61-65), but does not specifically teach the use of a PUK code. However, in an analogous art, Imura teaches if the person trying to activate the terminal enters more than a predetermined number of times a wrong identification code as a response to the said identification code requests, the user must enter a persona PUK code before user identification can be continued (Imura, column 13, lines 5-34).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use SIM card with multiple users with multiple numbers of Tayloe with the PUK code of Imura as a second layer of security for the account to limit the number of attempts to access a particular user account.

Response to Arguments

11. Applicant's arguments filed 6/2/2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that "the teaching of Tayloe is directed to different problem than the problem treated by the present application", a recitation of the intended use of the claimed invention must result in a structural difference between the

claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The invention of Tayloe clearly states that the SIM card that has a user with multiple phone numbers as well as multiple users for the mobile terminal (Tayloe, column 3, lines 62-65) and that PIN codes are used to activate the SIM card (Tayloe, column 2, lines 59-65) and individual accounts (column 5, lines 57-59).

In response to Applicant's argument that "identification data" is connected to a user identity and not to a certain phone number, the Examiner is not sure what the Applicant is arguing. Tayloe clearly shows the use of a PIN code to unlock a SIM card of a mobile terminal (Tayloe, column 2, lines 59-65) to identify the user to the mobile terminal and enable its use. He further teaches that the user with multiple phone numbers or another user may be required to enter additional PIN codes to enable another respective account (Tayloe, column 5, lines 57-59).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571 272 6962. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William S. Powers
Examiner
Art Unit 2134

Jacques H. Louis Jacques
JACQUES H. LOUIS JACQUES
PRIMARY EXAMINER